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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/765,146

01/28/2004

Guerino G. Sacripante

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OLIFF & BERRIDGE, PLC.

P.O. BOX 320850

ALEXANDRIA, VA 22320-4850

EXAMINER

ARNBERG, MEGAN C

ART UNIT

PAPER NUMBER

1796

NOTIFICATION DATE

DELIVERY MODE

06/09/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OfficeAction27074@oliff.com

jarmstrong@oliff.com

Office Action Summary	Application No. 10/765,146	Applicant(s) SACRIPANTE ET AL.	
	Examiner MEGAN ARNBERG	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 17-20 and 24-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 21-23 and 30-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/17/2007; 5/16/2005; 5/27/2004; 1/28/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I, claims 1-16, 21-23 and 30-38 drawn to a powder coating and a method of making in the reply filed on January 25, 2008 is acknowledged. The traversal is on the ground(s) that the subject matter of Group II is related to the subject matter of claim 1 and that there is not a serious burden to examine the entire application. This is not found persuasive because the product as claimed (powder) can be used in a materially different process of using that product, namely coating a cured polymer molded object, which is nonconductive. Also, the process for using the product as claimed can be practiced with another materially different product, such as with a powder formed by dry-melting and grinding. Further, there is a serious burden to examine the entire application since the groups of claims fall into different classifications, specifically the powder and method are classified in various subclasses of class 525 and the method is classified in class 427, subclass 180. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP 808.02), restriction for examination purposes as indicated is proper.

The requirement to elect species for the curable resin particles, the curing agent and the aggregant is withdrawn.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9, 21, 32, 33, 36-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Patel et al. (U.S. Pat. 6,210,853).

Regarding claims 1 and 3: Patel et al. teaches a process for forming a curable powder/toner comprising in an aqueous dispersion/latex, aggregating particles (abstract) such as a curable polyester resin (col. 1 lines 45-49), coalescing and removing/isolating the particles/toner (abstract).

Regarding claim 2: Patel et al. teaches the process takes place in the presence of an initiator and catalyst/curing agent (col. 4 lines 5-8).

Regarding claim 4: Patel et al. teaches mixing in a bisphenol A (col. 6 line 24) component, which would inherently act as a curing agent.

Regarding claims 5 and 6: Patel et al. teaches mixing with a colorant such as a pigment (col. 1 lines 45-49).

Regarding claim 7: The result of isolating the particles/toner of Patel et al. is a curable powder.

Regarding claim 8: Patel et al. teaches mixing in a bisphenol A (col. 6 line 24) component, which would inherently act as a curing agent.

Regarding claim 9: Patel et al. teaches the particle size is from 50-250 nanometers, which is 0.05-0.25 microns (col. 5 lines 12-14).

Regarding claim 21: Patel et al. teaches a polyester resin (col. 1 lines 45-49).

Regarding claim 32: Patel et al. teaches heating to a temperature below the Tg of the resin to aggregate the particles (col. 4 lines 19-21).

Regarding claim 33: Patel et al. teaches heating the aggregate particles to above the Tg of the resin to coalesce the particles/toner (col. 4 lines 23-27).

Regarding claim 36: Patel et al. teaches a geometric size distribution, GSD, from 1.15-1.24 (col. 4 line 63), which overlaps the claimed range.

Regarding claim 37: Patel et al. teaches a styrene-acrylate resin/poly(styrene-acrylate) (col. 6 line 26).

Regarding claim 38: Patel et al. teaches cyan, magenta and yellow pigments (col. 11 line 54).

Claims 10-16, 22, 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Patel et al. (U.S. Pat. 6,210,853).

Regarding claims 10 and 11: Patel et al. teaches a process for forming a curable powder/toner comprising in an aqueous dispersion/latex, aggregating particles (abstract) such as a curable polyester resin (col. 1 lines 45-49), coalescing and removing/isolating the particles/toner (abstract). Further, Patel et al. teaches the process takes place in the presence of an initiator and catalyst/curing agent (col. 4 lines 5-8).

Regarding claim 12: Patel et al. teaches mixing in a bisphenol A (col. 6 line 24) component, which would inherently act as a curing agent.

Regarding claims 13 and 14: Patel et al. teaches mixing with a colorant such as a pigment (col. 1 lines 45-49).

Regarding claim 15: The result of isolating the particles/toner of Patel et al. is a curable powder.

Regarding claim 16: Patel et al. teaches the particle size is from 50-250 nanometers, which is 0.05-0.25 microns (col. 5 lines 12-14).

Regarding claims 22 and 23: Patel et al. teaches a polyester resin (col. 1 lines 45-49).

Claims 1, 7, 34, 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Sacripante et al. (U.S. Pat. 5,989,629).

Regarding claim 1: Sacripante et al. teaches a process comprising aggregating a polymer latex/aqueous dispersion of resin and coalescing (col. 3 lines 40-45) followed by drying (col. 6 line 44), which would inherently remove the particles from the aqueous dispersion.

Regarding claim 7: The result of isolating the particles of Sacripante et al. is a curable powder.

Regarding claims 34 and 35: Sacripante et al. teaches a polyester resin in an amount of 75-95 percent and from about 5-25 percent of titanium oxide, which is a colorant (col. 7 lines 8-14), which overlaps the claimed ranges.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patel et al. (U.S. Pat. 6,210,853) as applied to claim 1 above and in further view of Davydov et al. (U.S. Pat. 6,491,973).

Regarding claims 30 and 31: Patel et al. teaches the basic process as set forth above. Not disclosed is dry-blending the fused particles with at least one additive. However, Davydov et al. teaches dry-mixing/dry-blending particles with additives such as filler (col. 2 lines 26-31). Patel et al. and Davydov et al. are combinable because they are both concerned with the same field of endeavor, namely resin particles for

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coating metal substrates. At the time of the invention a person having ordinary skill in the art would have found it obvious to combine the dry-mixing technique of Davydov et al. with the process of Patel et al. and would have been motivated to do so for such desirable properties as a more homogenous coating composition.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 5, 6 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, and 9 of U.S. Patent No. 5,593,807. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the patent teaches an aqueous dispersion/latex with a resin and a colorant being aggregated and coalesced and removed/dried as in claim 1 of the instant application. Claim 9 of the patent teaches

colorants/pigments as in claims 5 and 6 of the instant application. While the claims are not identical, the subject matter of the instant application is fully encompassed by the claims of the patent.

Claims 1, 5 and 6 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 17 of U.S. Patent No. 6,210,853. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the patent teaches an aqueous dispersion/latex comprising a resin which is mixed with a colorant, aggregated and coalesced and removed/isolated as in claim 1 of the instant application. Further claim 17 teaches the colorant is a pigment, as in claims 5 and 6 of the instant application. While the claims are not identical, the subject matter of the instant application is fully encompassed by the claims of the patent.

Claims 1, 30 and 31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 13, 27 and 28 of copending Application No. 10/765,327. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 13 of the copending application teaches a process comprising aggregating, in an aqueous dispersion, particles including resin particles, coalescing and removing from the aqueous dispersion as in claim 1 of the instant application. Further, claims 27 and 28 of the copending application are the same as claims 30 and 31 of the instant application. While the claims are not identical, the subject matter of the instant application is fully encompassed by the claims of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MEGAN ARNBERG whose telephone number is (571)270-3292. The examiner can normally be reached on Monday - Friday 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571) 272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. A./
Examiner, Art Unit 1796

/James J. Seidleck/
Supervisory Patent Examiner, Art Unit 1796